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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,854	06/27/2001	Rodrigo Garces	011727-92.00US	3678

20350 7590 12/02/2004

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EXAMINER

GESESSE, TILAHUN

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,854

Applicant(s)

GARCES ET AL.

Examiner

Tilahun B Gesesse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 10-17 and 19 is/are rejected.
- 7) ☒ Claim(s) 6, 8, 9, 18, 20 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This is in response to applicant's amendment and remarks filed June 10, 2004, in which claims 1-21 are pending.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/313846. Although the conflicting claims are not identical, they are

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not patentably distinct from each other because the claims in present application are conflicting with claims of co-pending application. The doctrine of double patenting seeks to prevent the unjustified extension of patent exclusivity beyond the term of a patent.

The public policy behind this doctrine is that:

The public should . . . be able to act on the assumption that upon the expiration of the patent it will be free to use not only the invention claimed in the patent but also modifications or variants which would have been obvious to those of ordinary skill in the art at the time the invention was made, taking into account the skill in the art and prior art other than the invention claimed in the issued patent.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5,7,10-17,19 are rejected under 35 U.S.C. 102(e) as being anticipated by Ricard et al "Richard" (US 2001/0007821).

Claim 1, Richard discloses a wireless communication system (page 2, para 0027-0032) having mobile subscriber units (terminal 1) in either fixed "static" or cordless "mobile" modes and a plurality of fixed network devices located at cell sites in a single

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network for communication (figure 1) with either static or mobile subscriber units, a method for acquiring and managing a plurality of communication modes at each subscriber unit (abstract), first searching "sensing" whether the subscriber unit is fixed or cordless "mobile" from the nature and quality of the communication links with nearby network devices (page 2, para 0028-0034), thereafter enabling an acquisition protocol suited to static mode and mobile mode for said subscriber unit (page 2, para 0038-0039) and enabling an acquisition protocol suited to mobile mode for mobile subscriber units and static mode for fixed subscriber units.(page 2, para 0040-0044).

Claims 2-3, Richard discloses multi-standard mobile telecommunication terminal 1 which is adapted to operate in a GSM , DCS or UMTS or similar public cellular network 2 (page 2 para 0027) , in these regard, then Richard teaches initiating procedures to change acquisition mode from static mode to mobile mode upon failure of the subscriber unit to search a preselected number of consecutive scheduled programming and processing events triggering for fixed or mobile, "pooling packets, such as in UMTS network, where packet switching used" sent by a linked device (page 1, para 0016).

Claim 4, Richard discloses decision to change mobile mode, foregoing best node qualification (page 2, para 0044).

Claim 5, Richard discloses decision to change mobile mode, forgoing registration of location with a name service (page 3,para 0056).

Claim 7, Richard discloses decision to change to mobile, forgoing query process (page 3 para 0054-0055).

Claim 10-12, they are system claims corresponding to system claim 1 above. Therefore, claims 10-12 are analyzed and rejected for same reason as set forth in the claim.

Claims 13-15, Richard discloses the subscriber unit (terminal 1) is sensed as fixed "static" or cordless "mobile" based on the nature and quality of the communication links with nearby network devices (page 2, para 0038-0039).

Claim 16, Richard discloses decision to change mobile mode, foregoing best node qualification (page 2, para 0044).

Claim 17, Richard discloses decision to change mobile mode, foregoing registration of location with a name service (page 3, para 0056).

Claim 19, Richard discloses decision to change to mobile, foregoing query process (page 3 para 0054-0055).

Allowable Subject Matter

4. Claims 6,8-9 and 18 and 20-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach upon decision to change to mobile mode, foregoing best node qualification; foregoing registration of location with a name service; foregoing third party query processes', and transmitting svnc packets at a higher repetititv.

Response to Arguments

5. Applicant's arguments with respect to claims 1-5,7,10-17,19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kojima et al (US 6,640,100) discloses micro cell and fixed terminal and repeaters interfacing wireless and static terminals (abstract and figure 1).

Noblins (2003/0017843) a method and system for enabling multiple use of a radiotelephone, also called station including in a radio communication system, it operates as mobile station and fixed station (abstract and figure 1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tilahun B Gesesse whose telephone number is 703-308-5873. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tilahun Gesesse
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November 15, 2004